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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,663	08/29/2001	Akiko Sato	NITT.0031	4771
38327	7590	05/24/2004	EXAMINER	
REED SMITH LLP 3110 FAIRVIEW PARK DRIVE, SUITE 1400 FALLS CHURCH, VA 22042			TANG, KUO LIANG J	
			ART UNIT	PAPER NUMBER
			2122	
DATE MAILED: 05/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	09/940,663	Applicant(s)	SATO ET AL.
Examiner	Art Unit		
Kuo-Liang J Tang	2122		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 29 August 2001.  
2a) This action is FINAL.                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-12 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

**,DETAILED ACTION**

1. This Office Action is in response to the amendment filed on 08/29/2001.

Claims 1-12 are pending and have been examined.

The priority date for this application is 11/09/2000.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohle US Patent No. 6,199,762.

As Per Claim 1, Hohle teaches that a system generally for personalizing and synchronizing smartcard data in the context of a distributed transaction system is disclosed. A dynamic smartcard synchronization system comprises access points configured to initiate a transaction in conjunction with a smartcard, an enterprise data collection unit, and a card object database update system. CODUS interfaces with personalization system in order to facilitate reissuance of the card by providing updated data in the event a card is destroyed, lost, or stolen. (E.g. see Abstract and associated text). In that Hohle discloses the method that covering the steps of:

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“in response to a request (E.g. see FIG. 9 REQUEST 901 and associated text) for loading one application program (E.g. see FIG. 9, Gather Application 906 and associated text) for a smart card (E.g. see FIG. 1 smart cards 120 and associated text) in the smart card that has been reissued (E.g. see FIG. 9 card request 901 and associated text, e.g. col. 9:25-34) based on an old smart card, judging whether or not said one application program was loaded in the old smart card (E.g. see col. 6:12-24, application) according to a relationship between a card id of the reissued smart card (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database ) and a card id (E.g. see col. 6:15-16, card indicia) of the old smart card; and if it is found out that said one application program was loaded, loading said one application program in the reissued smart card.” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text).

As Per claim 2, the rejection of claim 1 is incorporated and further Hohle teaches:

“preparing a database (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database ) for storing a card id of an individual smart card, and data for identifying one or more application programs loaded in the individual smart card, while associating the card id with the data (E.g. see col. 6:12-24, application); and when a request for loading said one application program (E.g. see FIG. 9, Gather Application 906 and associated text) is received, judging whether or not said one application program was loaded in the old smart card, using a card identification number of the reissued smart card as a key (E.g. see col. 6:15-16, card indicia).”

As Per claim 3, the rejection of claim 1 is incorporated and further Hohle teaches:

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“when the reissued smart card is issued to a user, data indicating a relationship between the card id of the reissued smart card and the card id of the old smart card is supplied from a card issuer of the reissued smart card (E.g. see col. 2 19-20, card issuing party) to the service provider (E.g. see col. 2 19-20, American Express) that provides service of loading said one application program in the smart card.”

As Per claim 4, the rejection of claim 1 is incorporated and further Hohle teaches:

“providing the reissued smart card issuer with the card id of the reissued smart card;” (E.g. see FIG. 1 smartcards 120 and associated text);

“requesting (E.g. see FIG. 9 REQUEST 901 and associated text) the reissued smart card issuer to provide card id data of the old smart card, on which the reissued smart card is based;” and

“according to the card id data of the old smart card obtained in response to the request, if it is found out that said one application program was loaded in the old smart card, loading said one application program in the reissued smart card.” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text).

As Per claim 5, the rejection of claim 1 is incorporated and further Hohle teaches:

“preparing a database (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database ) for storing a card id of an individual smart card, and data for identifying one or more application programs loaded in the individual smart card, while associating the card id with the data;” and

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“if the card id data of the old smart card is obtained, judging whether or not said one application program was loaded in the old smart card.” (E.g. see FIG. 9, Gather Application 906 and associated text).

As Per claim 6, Hohle teaches:

“when a request (E.g. see FIG. 9 REQUEST 901 and associated text) for loading one application program in one smart card is received, obtaining card attribute data (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database), which includes information for identifying the smart card from among other smart cards, from said one smart card,”

“supplying the card attribute data and an id of said one application program from the service provider (E.g. see col. 2 19-20, American Express), which will load said one application program, to an issuer of said one smart card (E.g. see col. 2 19-20, card issuing party);” (E.g. see FIG. 1 CODUS 106 and Personalization 140 and associated text);

“identifying a card id of said smart card from the card attribute data by the smart card issuer that has received the information;” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database);

“if it is found out that the smart card is a reissued smart card, identifying an old smart card on which the reissued smart card is based;” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database);

“if it is found out that one of application programs loaded in the old smart card is said one application program, supplying a message id (E.g. FIG. 11 field name 1102 and associated text, e.g. col. 5:25-37) exchanged between the smart card issuer and the service provider (E.g. see

FIG. 2 router 206 and associated text), which relates to permission for loading said one application program in the old smart card, from the smart card issuer to the service provider;” and

“according to the message id data, determining whether or not the request for loading said one application program in said one smart card is permitted.” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text).

As Per claim 7, the rejection of claim 6 is incorporated and further Hohle teaches: “the card attribute data is data that is loaded in the smart card, and that permits this smart card to be distinguished from other smart cards.” (E.g. see col. 9:28-34, characteristics).

As Per claim 8, the rejection of claim 6 is incorporated and further Hohle teaches: “the message id is an id (E.g. FIG. 11 field name 1102 and associated text, e.g. col. 5:25-37) of an electronic message that has been exchanged (E.g. see FIG. 2 router 206 and associated text) between the card issuer and the service provider.”

As Per claim 9, the rejection of claim 6 is incorporated and further Hohle teaches: “said card attribute data is encrypted.” (E.g. see FIG. 2 SECURITY ENGINE 202 and associated text).

As Per claim 10, the rejection of claim 9 is incorporated and further Hohle teaches:

“the service provider does not have a means for decrypting the card attribute data, but the smart card issuer has the means.” (E.g. see FIG. 2 SECURITY ENGINE 202, FIG. 3 SECURITY ENGINE 304, FIG. 4 SECURITY ENGINE 406 and associated text).

As Per claim 11, Hohle teaches:

“in response to a request (E.g. see FIG. 9 REQUEST 901 and associated text) for loading one application program (E.g. see FIG. 9, Gather Application 906 and associated text) for a smart card (E.g. see FIG. 1 smart cards 120 and associated text) in the smart card that has been reissued (E.g. see FIG. 9 card request 901 and associated text, e.g. col. 9:25-34) based on an old smart card, judging whether or not said one application program was loaded in the old smart card (E.g. see col. 6:12-24, application) according to a relationship between a card id of the reissued smart card (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database ) and a card id (E.g. see col. 6:15-16, card indicia) of the old smart card;” and

“if it is found out that said one application program was loaded, loading said one application program in the reissued smart card (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text). wherein:”

“if the service provider can read (E.g. see FIG. 1 ACCESS POINTS 102 and associated text) the card id of the reissued smart card, whether or not said one application program was loaded in the old smart card is judged on a service provider side; (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text)” and

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“if the service provider cannot read (E.g. see FIG. 1 ACCESS POINTS 102 and associated text) the card id of the reissued smart card, whether or not said one application program was loaded in the old smart card is judged on a smart card issuer side (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text).”

As Per claim 12, Hohle teaches:

“when a request (E.g. see FIG. 9 REQUEST 901 and associated text) for loading one application program in one smart card is received, determining a kind of said one smart card, that is, a reissued smart card or a newly issued smart card (E.g. see FIG. 9, Gather Application 906 and associated text);”

“if it is found out that said one smart card is a reissued smart card, judging whether or not said one application program was loaded in the old smart card, according to a relationship between a card id of the reissued smart card (E.g. see FIG. 1 CODUS 106 and associated text, e.g. database ) and a card id (E.g. see col. 6:15-16, card indicia) of the old smart card on which the reissued smart card is based;” and

“if it is found out that said one application program was loaded, loading said one application program in the reissued smart card.” (E.g. see FIG. 1 CODUS 106 and associated text, e.g. col. 3:61-67, reissuance of card and see FIG. 1 Personalization system 140 and FIG. 9 and associated text).

*Conclusion*

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang J Tang whose telephone number is 703-305-4866. The examiner can normally be reached on M-F 8:30 to 5:00.

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on 703-305-4552.*

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306.

*Kuo-Liang J. Tang*

Software Engineer Patent Examiner

*tsd*  
TUAN DAM  
SUPERVISORY PATENT EXAMINER